

### **Remarks/Arguments**

Claims 119-123 and 132-135 have been canceled without prejudice or disclaimer. Claim 136 has been amended for proper claim dependency. Accordingly, Claims 124, 129-131 and 136 are currently pending in this application. Rejections to these claims are respectfully traversed.

### **Claim Rejections - 35 U.S.C. §101 and §112, first paragraph**

Claims 119-123 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility.

Claims 119-123 are further rejected under 35 U.S.C. 112, first paragraph since allegedly one skilled in the art clearly would not know how to use the claimed invention.

Without acquiescing to the propriety of this rejection, merely to expedite prosecution in this case, Applicants have canceled Claims 119-123 without prejudice or disclaimer. Accordingly, this rejection is moot and should be withdrawn.

### **Claim Rejections – 35 USC § 102**

Claims 119-122, 130-131 and 132-135 remain rejected under 35 U.S.C. §102(a) as being anticipated by Jacobs (WO 98/32853, dated July 30, 1998).

Claims 119-123 and 132-135 have been canceled without prejudice or disclaimer; hence rejections directed to these claims are moot. Further, claims 130-131 depend either directly or indirectly on allowable claim 124.

Also, the Examiner acknowledged that the Applicants are entitled to the priority date of **August 18, 1998** for this application but finds the declaration filed under 37 C.F.R. §1.131 defective because it was not signed by all the inventors of the rejected claims.

Applicants submit that due to amendments made to the claims during prosecution, the inventorship for the instant application has changed. Applicants filed an amendment for correction of the inventorship for this case on April 18, 2005 under 37 C.F.R. §1.48(b). Further, Applicants hereby file a newly executed declaration reflecting all the current inventors of the invention under 37 C.F.R. §1.131, namely, Luc Desnoyers, Audrey Goddard, Paul Godowski, Austin Gurney and William Wood. Applicants believe that this declaration should be sufficient to obviate the instant rejection anticipated by Jacobs since Applicants had cloned and sequenced

the nucleic acid on May 29, 1998, thereby predating the Jacobs reference. Accordingly, claims 139-142 are not anticipated by Jacobs *et al.* and therefore, this rejection should be withdrawn.

*A copy of the executed declaration by Austin Gurney will be filed shortly.*

20-21. Claims 132-135 are rejected under 35 U.S.C. §102(e) as being anticipated by Edwards (USPN 6,312,922, priority date 2/9/1998 and USPN 6,222,029, filed 8/1/1997).

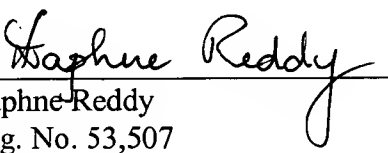
In view of the cancellation of claims 132-135 without prejudice or disclaimer, this rejection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C39). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: June 10, 2005

  
Daphne Reddy  
Reg. No. 53,507

**HELLER EHRMAN, LLP**  
**Customer No. 35489**  
275 Middlefield Road  
Menlo Park, California 94025  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638